IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
FERNANDEZ *et al.*	)	Examiner: VO, TUNG T.
	)	
Application No. 09/823,089	)	Art Unit: 2613
	)	
	)	
Filed: 03/29/2001	)	
	)	
For: INTEGRATED NETWORK	)	
FOR MONITORING REMOTE	)	
OBJECTS	)	
	)	
	)	

APPEAL BRIEF

IN SUPPORT OF APPELLANTS' APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

The Appellant hereby submit, in triplicate, the following Brief pursuant to 37 CFR 1.192

in support of the appeal from a final decision by the Examiner, dated October 13, 2005, and

advisory action dated January 25, 2006, in the above-captioned case. The Appellant respectfully

request consideration by the Board of Patent Appeals and Interferences for allowance of the

above-captioned patent application.

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I. Real party in interest

The real party in interest is Dennis Fernandez, an individual, having a residence at 1175 Osborn Avenue, Atherton, CA 94027. He is also the U.S. Patent Attorney prosecuting this appeal.

II. Related appeals and interferences

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal, which will directly affect, be directly affected by, or have a bearing on the Board's decision.

III. Status of claims

Claims 37-66 are currently pending and each claim stands rejected and entered by the Examiner for purposes of appeal. Claims 1-36 have been cancelled. Claims 37 and 52 are independent claims.

Previously in Final Office Action mailed on October 13, 2005, Examiner rejected claims 37-38, 42, 44, 52-54, 57, and 59 as being anticipated by DeLorme et al. under 35 U.S.C. 102(e). Examiner rejected claim 39 as being unpatentable over DeLorme et al in view of Hollenberg under 35 U.S.C. 103(a), claims 43 and 58 as being unpatentable over DeLorme et al. in view of Heikari et al. under 35 U.S.C. 103(a), claims 40-41 and 55-56 as being unpatentable over DeLorme et al. in view of Joao et al. under 35 U.S.C. 103(a), claims 45 and 60 as being unpatentable over DeLorme et al. in view of McGregor et al. under 35 U.S.C. 103(a), claims 46 and 61 as being unpatentable over DeLorme et al. in view of Rudrapatna et al. under 35 U.S.C. 103(a), claims 47-48 and 62-63 as being unpatentable over DeLorme et al. in view of Kennedy,

III et al. under 35 U.S.C. 103(a), claims 49 and 64 as being unpatentable over DeLorme et al. in view of David et al. under 35 U.S.C. 103(a), claims 50 and 65 as unpatentable over DeLorme et al. in view of Uppaluru under 35 U.S.C. 103(a), and claims 51 and 66 as being unpatentable over DeLorme et al in view of Almeida et al. under 35 U.S.C. 103(a).

IV.   Status of amendments

All claims 37-66 on appeal are provided in the **Appendix**, as filed in Amendment dated November 1, 2005.

V.   Summary of invention

The invention is a cellphone for communicating with a networked controller comprising a wireless communicator, a locator for providing a cellphone location, a sensor for providing an image, audio, or video signal of a cellphone user to the networked controller, and a processor for accessing a communication module for enabling voice or video over Internet-Protocol streaming via the wireless communicator. The communication module, being partitionable or uninstallable as a functional component, comprises a user-customizable or reconfigurable software program, firmware or circuit accessible locally in the cellphone or remotely via the network. The communication module is provided in layered or hierarchical arrangement, such that a first-level functionality is provided by a database and an object movement module, and a next-level functionality is provided by the communication module and a security mode.

Additionally, the invention includes a method for communicating with the networked controller.

VI.   Issues

An issue presented in this appeal is whether claims 37-38, 42, 44, 52-54, 57, and 59 are

anticipated by DeLorme et al. under 35 U.S.C. §102(e).

Another issue presented in this appeal is whether the Examiner has established a *prima*

facie case of obviousness under 35 U.S.C. § 103(a) by relying on DeLorme et al. in conjunction

with any other reference to reject claims 39-41, 43, 45-51, 55-56, 58, and 60-66.

Further, another issue presented in this appeal is whether there is a suggestion or

motivation in DeLorme et al. to combine the prior art references.

More specifically, the main issue on appeal is whether the Examiner properly applied the

key reference, Delorme et al., to the claimed invention to warrant a rejection under 35 U.S.C.

§102(e) or 35 U.S.C. §103(a).

VII.   Grouping of claims

In this appeal, all pending claims 37-66 stand or fall together.

VIII.   Argument
A. Independent Claims 37 and 52 are not anticipated by DeLorme et al.
under 35 U.S.C. §102(e).

In the Final Office Action dated October 13, 2005, Examiner rejected independent claims

37 and 52 and all other pending claims relying on the disclosure of DeLorme et al. (US

5,948,040) which is the subject of this appeal brief. Applicants believe Examiner has misapplied

the DeLorme et al. reference, briefly discussed below, to the present invention.

i. Overview of DeLorme et al. reference

DeLorme et al. discloses a Travel Reservation Information and Planning System (TRIPS)

"that provide[s] travel information and special offers for goods and services such as

accommodations and reservations associated with such areas of interest." (DeLorme et al., Col. 1, Lines 33-37). The system "permit[s] individuals to make travel arrangements and to plan travel activities, including such systems that are accessible via interconnected computer networks." (DeLorme et al., Col. 1, Lines 29-32). "In general then, the TRIPS invention provides flexible, selective input for a great variety of simple or complex sequential travel planning inquiries, as motivated and suited to the requirements, preferences and idiosyncrasies of individual TRIPS users." (DeLorme et al., Col. 10, Lines 59-63).

ii. Claim 37

Claim 37, from which claims 38-51 depend, were rejected by Examiner as anticipated by DeLorme et al. However, contrary to Examiner's contentions, the figures and associated texts of Delorme et al. do not teach nor suggest all of the claim limitation recited in Claim 37 for the following reasons.

In particular, the communication module comprises a user-customizable or reconfigurable software program, firmware or circuit. Examiner relies on figure 4 of DeLorme et al. to teach the software program. Examiner further argues that DeLorme et al. teaches that a user can "input request WHAT, WHEN, WHERE AND HOW." (Final Office Action, Page 4). Examiner, however, has misapplied this reference. DeLorme et al. discloses that a user can change variables of a software program to affect the outcome of certain algorithms. The software performs the same algorithm but with different inputs. Thus, outcomes may differ but the software program does not change, hence such disclosure does not disclose or suggest Appellants' claimed invention.

In particular, DeLorme fails to provide, as required by Appellants' claims, the limitation that "communication module is provided in layered or hierarchical arrangement, such that a first-level functionality is provided by a database and an object movement module, and a next-level functionality is provided by the communication module and a security module." In this regard referring specifically to DeLorme, Examiner previously argued (10/13/2005 office action, pages 4-5): "wherein the communication module is provided in layered or hierarchical arrangement *(fig. 2)*, such that a first-level functionality is provided by a database *(221 of fig. 2)* and object movement module *(213 of fig. 2, note "locatable" textual)*, and a next-level functionality by the communication module *(209 of fig. 2, 203 of fig. 2, also 904 of fig. 2)* and a security module *(217 of fig. 2, note confidential user, account user, password, or planned-saved strips)*." However notwithstanding such argument by Examiner, DeLorme fig. 2 block diagram merely shows "major components of the novel travel reservation information planning system (TRIPS) invention" (col. 30, lines 58-60.) And DeLorme merely says that various subsystems 221, 217, 213 "handle TRIPS user inquiries directed to place, time, topic and transaction decisions (col. 31, lines 9-11), and that "the TRIPS interface & interaction bus 209 functions to furnish flexible user-directed access to, from and among the four subsystems at 221, 223, 213 and 217 within TRIPS" (col. 31, lines 19-22). Thus there is no teaching or suggestion by DeLorme (or any other cited reference) of Appellants' essentially claimed limitation of communication module being provided in **layered or hierarchical arrangement**, such that a **first-level functionality** is provided by a database and an object movement module, and **next-level functionality** being provided by the communication module and a security module.

On the contrary against Examiner's mis-applied argument, DeLorme actually specifies that his invention for a "travel reservation information and planning system" must be "completely integrated" (col. 1, lines 36-47); "therefore, what is needed is a system with such complete integration of all aspects of travel/activity by a user" (col. 6, lines 47-48). Hence because DeLorme contemplates completely that "the TRIPS invention facilitates integration between travel information from prior steps in a TRIPS session with ensuing component operations in a given travel planning session (col. 34, lines 57-60), this key reference neither teaches nor suggests Appellants' functionally un-integrated scheme, i.e., which among other things necessarily provides functional modules arranged in separate functional levels that are either layered or hierarchical, "wherein the communication module is provided in **layered or hierarchical arrangement**, such that a **first-level functionality** is provided by a database and an object movement module, and **next-level functionality** being provided by the communication module and a security module."

Accordingly, contrary to Examiner's contention, DeLorme et al. fails to teach all of the claim limitations recited in claim 37 and thus a 35 U.S.C. §102(e) rejection is improper.

iii. Claim 52

Claim 52, from which claims 53-66 depend, recites similar claim limitations recited in claim 37. For the same reasons stated above with respect to claim 37, claims 52-66 are not anticipated by Delorme et al. Accordingly, contrary to Examiner's contention, DeLorme et al. fails to teach all of the claim limitations recited in claim 52 and thus a 35 U.S.C. §102(e) rejection is improper.

iv. Thus, Claims 37 and 52 are not anticipated by the DeLorme et al. reference.

Respectfully, Examiner is misguided by Delorme's disclosure because Appellant's claim limitation is not found in DeLorme's figures or specification. Accordingly, for the foregoing reasons, Appellant respectfully submits that independent claims 37 and claim 52 are not anticipated by DeLorme et al. Thus, Examiner's rejections of claims 37-66 are erroneous and should be overcome.

B. The Examiner fails to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a).

According to MPEP 7602.02, to establish a *prima facie* case of obviousness, a prior art reference (or references when combined) must teach or suggest all the claim limitations. Thus, the examiner bears a burden of establishing a *prima facie* case of obviousness; and when the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995). Furthermore, when the prior art references teach all the limitations of a patent's claim except one specific feature, an obviousness challenge to the patent's validity shall be rejected. *WMS Gaming Inc. v. International Game Technology,* 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999).

Examiner has rejected claims 39-41, 43, 45-51, 55-56, 58, and 60-66 under 35 U.S.C. § 103(a) by relying on DeLorme et al. as a primary reference. As discussed above with respect to claims 37 and 52, Delorme et al. reference does not teach all of the claimed limitations. Thus, Examiner has not established a *prima facie* case of obviousness.

Accordingly, for the foregoing reasons, Appellant respectfully submit that all claims rejected under 35 U.S.C. §103(a) are patentable over DeLorme et al.

C. There is no suggestion or motivation in DeLorme et al. to combine a second prior art reference.

When a patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. *Northern Telecom Inc. v. Datapoint Corp.,* 908 F.2d 931, 15 USPQ2d (Fed. Cir. 1990), *cert. denied,* 298 U.S. 920 (1990); and for the claimed subject matter to be obvious in view of a combination of prior art references, the prior art must suggest the combination to one of ordinary skill in the art and reveal that one of such skill would have a reasonable expectation of success in carrying out the invention. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

More importantly the showing of a suggestion, teaching, or motivation to combine prior teachings must be clear and particular. *In re Dembiczak,* 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). And if a reference disclosure is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. *In re Clay,* 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

DeLorme et al. teaches away from a combination. The disclosure of DeLorme et al. "relates to a completely integrated system." (DeLorme et al., Col. 1, Line 39). As the TRIPS system is "completely integrated," DeLorme effectively rules out the possibility of integrating additional features. Therefore, there is no motivation or suggestion to combine the prior art references.

Accordingly, for the foregoing reasons, Appellant respectfully submit that all claims rejected under 35 U.S.C. §103(a) are patentable over DeLorme et al.
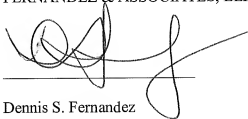
CONCLUSION

Hence in this Appeal Brief, Appellants respectfully conclude that the Examiner was in error to reject claims 37-38, 42, 44, 52-54, 57 and 59 as anticipated over DeLorme et al. under 35 U.S.C. 102(e) and claims 39-41, 43, 45-51, 55-56, 58, and 69-66 as obvious over DeLorme et al. under 35 U.S.C. 103(a).

Respectfully Submitted,

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IX.   Appendix

A. Claims Appendix

Claims Presented For Appeal
(as filed via Rule-116 Amendment dated 11/01/2005)

1-36. (CANCELED)

37. (PREVIOUSLY PRESENTED) Cellphone for communicating with a networked

controller comprising:

a wireless communicator for communicating remotely with a networked controller via a

network;

a locator for providing a cellphone location to the networked controller via the wireless

communicator;

a sensor for providing an image, audio, or video signal of a cellphone user for

transmission to the networked controller via the wireless communicator; and

a processor for accessing a communication module for enabling voice or video over

Internet-Protocol streaming via the wireless communicator, the communication module

comprising a user-customizable or reconfigurable software program, firmware or circuit

accessible locally in the cellphone or remotely via the network, the communication module being

partitionable or uninstallable as functional component, the voice or video stream being wirelessly

communicated by the wireless communicator effectively via a data channel to a wireless Internet

service provider;

wherein the communication module is provided in layered or hierarchical arrangement,

such that a first-level functionality is provided by a database and an object movement module,

and a next-level functionality is provided by the communication module and a security module.

38. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the locator comprises a global positioning satellite (GPS) receiver.

39. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the sensor comprises a camera capable of recording the image, audio or video signal, and recognizing the cellphone user voice or image.

40. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 further comprising:

a processor for running a transaction program for metering usage by the cellphone user.

41. (PREVIOUSLY PRESENTED) The cellphone of Claim 40 wherein:

the processor enables a local advertisement message that is pertinent to the cellphone location to be presented to the cellphone user.

42. (PREVIOUSLY PRESENTED) The cellphone of Claim 40 wherein:

the processor runs a simulation of a cellphone user movement or behavior.

43. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the wireless communicator communicates within a group of cellphones chatting privately in multi-cast mode using an embedded watermark or digital certificate, thereby securing such group communication electronically.

44. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the wireless communicator communicates within a restricted temporal or geographic range for transaction, thereby enabling cellphone transactions only during unrestricted time or location.

45. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the wireless communicator receives electronically a media stream or application program from the network controller according to transaction subject to a tax rate at the cellphone location.

46. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the locator provides a location based temporarily on the cellphone acceleration or signal triangulation, thereby enabling the cellphone location to be provided during a wirelessly-inaccessible down period.

47. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the sensor provides a medical monitoring signal from sensing physically a biological condition of the cellphone user, thereby enabling health-care service according to a health-insurance coverage of the cellphone user.

48. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the sensor provides a vehicle diagnostic signal from sensing electronically a mechanical condition of an automobile coupled to the cellphone, thereby enabling a neural network to diagnose the automobile adaptively.

49. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the sensor provides a residential surveillance signal from sensing a security condition of personal property coupled to or nearby the cellphone, thereby enabling remote surveillance of such property movement or safety.

50. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the wireless communicator receives electronically an audio/visual signal from the network controller according to an extensible markup language (XML) tag or software agent associated with the audio/visual signal, thereby enabling advertisement for local goods or services to be included with the audio/visual signal based upon the cellphone location.

51. (PREVIOUSLY PRESENTED) The cellphone of Claim 37 wherein:

the image, audio or video signal is provided in a multi-media simulation program to represent the cellphone user and location in three-dimensions, virtual-reality or holographically.

52. (PREVIOUSLY PRESENTED) Method for cellphone communication with a networked controller comprising the steps of:

communicating by a cellphone with a networked controller via a network; and

providing a cellphone location, and an image, audio, or video signal of a cellphone user to the networked controller;

wherein the cellphone accesses a communication module for enabling voice or video over Internet-Protocol streaming, the communication module comprising a user-customizable or reconfigurable software program, firmware or circuit accessible locally in the cellphone or remotely via the network, the communication module being partitionable or uninstallable as functional component, the voice or video stream being wirelessly communicated effectively via a data channel to a wireless Internet service provider;

wherein the communication module is provided in layered or hierarchical arrangement, such that a first-level functionality is provided by a database and an object movement module, and a next-level functionality is provided by the communication module and a security module.

53. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone location is provided by a global positioning satellite (GPS) receiver.

54. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone user voice or image is recognized from the image, audio or video signal.

55. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

a processor runs a transaction program for metering usage by the cellphone user.

56. (PREVIOUSLY PRESENTED) The method of Claim 55 wherein:

the processor enables a local advertisement message that is pertinent to the cellphone location to be presented to the cellphone user.

57. (PREVIOUSLY PRESENTED) The method of Claim 55 wherein:

the processor runs a simulation of a cellphone user movement or behavior.

58. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone communicates within a group of cellphones chatting privately in multi-cast mode using an embedded watermark or digital certificate, thereby securing such group communication electronically.

59. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone communicates within a restricted temporal or geographic range for transaction, thereby enabling cellphone transactions only during unrestricted time or location.

60. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone receives electronically a media stream or application program from the network controller according to transaction subject to a tax rate at the cellphone location.

61. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone location is provided temporarily based on the cellphone acceleration or signal triangulation, thereby enabling the cellphone location to be provided during a wirelessly-inaccessible down period.

62. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone provides a medical monitoring signal from sensing physically a biological condition of the cellphone user, thereby enabling health-care service according to a health-insurance coverage of the cellphone user.

63. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone provides a vehicle diagnostic signal from sensing electronically a mechanical condition of an automobile coupled to the cellphone, thereby enabling a neural network to diagnose the automobile adaptively.

64. (PREVIOUSLY PRESENTED) The method of Claim 51 wherein:

the sensor provides a residential surveillance signal from sensing a security condition of personal property coupled to or nearby the cellphone, thereby enabling remote surveillance of such property movement or safety.

65. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the cellphone receives electronically an audio/visual signal from the network controller according to an extensible markup language (XML) tag or software agent associated with the audio/visual signal, thereby enabling advertisement for local goods or services to be included with the audio/visual signal based upon the cellphone location.

66. (PREVIOUSLY PRESENTED) The method of Claim 52 wherein:

the image, audio or video signal is provided in a multi-media simulation program to represent the cellphone user and location in three-dimensions, virtual-reality or holographically.

B. Evidence appendix

None.

C. Related proceedings appendix

None.